

submitted a Terminal Disclaimer, disclaiming the term of any patent issuing from the present application which would extend beyond the term of the '660 patent.

The claims have been newly rejected under 35 U.S.C. § 103(a) over Reichle et al. U.S. Patent 5,952,146, filed June 27, 1996 (hereafter, "*Reichle*"). The *Reichle* filing date is later than the filing date of the parent application of the present application, and is less than one year prior to the filing date of the present application, June 10, 1997. Applicants were unaware of the Nagy filing at the time the present application was filed.

The present rejection under 35 U.S.C. § 103(a) over Nagy cannot be maintained, as Applicants reduced their invention to practice prior to the Nagy filing date. Ordinarily, prior conception and/or reduction to practice is introduced into evidence via a Declaration or Affidavit under 37 C.F.R. § 1.131. However, in the present case, the prior filed application, together with its Declaration which indicates that the inventors believe themselves to be the original joint inventors of the subject matter of that application, is legally sufficient to take the place of a Declaration under 37 C.F.R. § 1.131, and are incorporated herein for that purpose.

It is well established that an antedating Declaration need only show a conception and/or reduction to practice of as much as the reference shows, provided that if the reference is a U.S. patent, the claims do not claim the same subject matter. *In re Stempel*, 113 U.S.P.Q. 77 (CCPA 1957).

Here, there is no question that the *Reichle* reference does not claim the same subject matter. While the *Reichle* disclosure describes pyridinyloxy and quinolinyloxy catalysts which contain 1 pyridinyloxy or quinolinyloxy ring system, or catalysts containing two or more of such ring systems, the *Reichle* claims were amended to recite only catalysts with bridged pyridinyloxy or quinolinyloxy rings. During the prosecution of *Reichle*, the issued Nagy patent was cited. As a result, *Reichle* amended his claims to exclude non-bridged catalysts, thereby acknowledging that Nagy was the first inventor of such catalysts. Thus,

there is no overlap of the presently claimed compounds and those of *Reichle*. The rationale of *Stempel* thus clearly applies to the present case.

Stempel and like cases pertain to the situation where a prior art reference discloses one or more species within a claimed genus. *Stempel* showed a reduction of practice of the disclosed species prior the effective date of the reference. However, the Examiner, affirmed by the Board, maintained that the showing in the Declaration must be commensurate with the scope of the claim. The CCPA reversed, holding clearly that to antedate a reference which discloses, but does not claim, the later claimed subject matter, the Declaration need only show as much as the reference. The showing need not be commensurate with the scope of the claim. *Stempel* at 81.

Furthermore, *Stempel* indicated that

In the case of a reference, it is fundamental that it is valid only for what it discloses and if the applicant establishes priority with respect to that disclosure, and there is no statutory bar, it is of no effect at all. (Emphasis added).¹

The Court further stated:

The rule [131] must be construed in accordance with the rights given to inventors by statute and this excludes a construction permitting the further use of a reference as a ground of rejection after all pertinent subject matter in it has been antedated to the satisfaction of the Patent Office.

Thus, the ability of an applicant to rely on antedating evidence, as conferred by the rule, must be interpreted liberally. Once the antedating nature (anticipation) has been disposed of, the reference is not available for use for any other purpose, e.g., a rejection for obviousness.

¹As *Reichle* was not filed more than one year prior to the present application, there is no statutory bar.

In accord with *Stempel* are several oft cited cases which expand its holding considerably. In *In re Hostettler*, 148 U.S.P.Q. 514 (CCPA 1966), the prior art reference publication showed the preparation of a polyurethane foam by the reaction of polyfunctional alcohols with polyfunctional isocyanates in the presence of a tin catalyst (tin octoate) to produce a polyurethane foam. The applicant claimed the preparation of a urethane (a polyurethane is a methane) by reaction of a compound containing at least one isocyanate group (mono- or polyisocyanate) and a compound having at least one alcohol group (monol or polyol) using tin octoate as a catalyst. To overcome the reference publication, *Hostettler* submitted an affidavit showing the effect of tin octoate in catalyzing the reaction between phenylisocyanate and methanol. The Office declared the affidavit insufficient, since, while within the scope of the claim, it failed to antedate the species of the reference: a polyurethane produced from polyisocyanate and polyol. The Board attempted to distinguish this case from *Stempel* on this basis.

The CCPA reversed, however. The Court indicated that the reduction to practice attested to in the Rule 131 affidavit would have rendered the reference disclosure obvious, and was therefor sufficient:

Certainly appellants should not be required to submit facts under Rule 131 showing that they reduced to practice that which is obvious in addition to those facts offered as showing a completion of the invention, for the purposes of antedating a reference.

Also in accord, and highly on point, is *In re Clarke*, 148 U.S.P.Q. 670 (CCPA 1966). In *Clarke*, the claims were directed to diacylhexahydropyridazines, in which the "R" group of the acyl groups could be selected from numerous radicals. The claims were rejected over a publication which disclosed diacylhexahydropyridazines where the R groups were isopropyl (specifically claimed by *Clarke*). *Clarke* submitted an affidavit under Rule 131 showing reduction to practice of diacylhexahydropyridazines when the R groups were methyl and phenyl. The rejection of the claims was maintained over this showing. The CCPA reversed. The Court stated:

It is clear from *In re Shokal*, 44 CCPA 854, 242 F.2d 771, 113 USPQ 283, that appellant may, by a proper showing, overcome a reference which discloses a species within the generic claim, although he may not be able to show completion of that species prior to the effective date of the reference, where the reference is not a statutory time bar.² Thus, indirect antedating of a reference is permitted in a proper case and the solicitor's view is contrary to existing law.

The Court further stated:

We believe the rule in *Stempel* supplements our decision in *In re Shokal*, *supra*, and that the rule for antedating references is not limited to fact situations where the inventor can show priority as to the *identical* compound described in the reference. It seems that in an appropriate case an applicant should not be prevented from obtaining a patent to an invention where a compound described in a reference would have been obvious to one of ordinary skill in the art in view of what the affiant proves was completed with respect to the invention prior to the effective date of the reference. This is particularly true where the inventor had already appreciated that the invention was generic in nature from the work on diverse species and was endeavoring to determine by exercise of reasonable diligence the precise scope of the invention.³

...

It follows from the above views that antedating affidavits must contain facts showing a completion of "the invention" commensurate with the extent the invention is shown in the reference, whether or not it be a showing of the identical disclosure of the reference. In our view, where it can be concluded that facts, offered in a Rule 131 affidavit in support of a general allegation of conception and reduction to practice of the invention, would persuade one of ordinary skill in the art to a reasonable certainty that the applicant possessed *so much of the*

²As stated previously, *Reichle* is not a statutory bar.

³Exactly the case here.

invention as to encompass the reference disclosure, then that showing should be accepted as establishing prima facie a case of inventorship prior to the reference, sufficient for the purpose of overcoming the reference in an ex parte case.

Here, the present claims have been alleged by the Office to be obvious over the applicants own prior parent patent, and also over *Reichle*. *Reichle* has admitted, by his restriction of claims in view of the Nagy patent, that his non-bridged catalysts were anticipated and/or obvious over Nagy. There can be no argument, therefore, that *Reichle* is not obvious over Nagy '660. Because the Nagy '660 disclosure to which the present application claims priority predates the *Reichle* disclosure; and because the *Reichle* disclosure is obvious over that of Nagy '660; and because the present application contains the entire Nagy '660 disclosure, the Nagy '660 application, with its Declaration, fully meets the legal requirements to supplant an antedating Declaration under 37 C.F.R. § 1.131. The Nagy '660 application contains concrete Examples within the scope of *Reichle* (same identical) which antedate in terms of novelty, and also in terms of obviousness. There should be no need for a separate Declaration. The earlier filed application serves this purpose. The rejection of the claims in view of *Reichle* thus cannot be maintained.

Applicants submit that the claims are now in condition for Allowance, and respectfully request a Notice to that effect. If the Examiner believes that further discussion will advance the prosecution of the Application, he is highly encouraged to telephone Applicants' attorney at the number given below.

Respectfully submitted,

NAGY ET AL.

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